

## **REMARKS**

The Applicants have thoroughly considered the Official Action dated August 24, 2006, and have prepared this Response to Office Action in response thereto. The Applicants have concurrently filed a Petition to Revive Unintentionally Abandoned Application, and the required petition fee. As the Applicants respectfully disagree with the Examiner's rejections, no amendments have been made. The following remarks will follow the order set forth in the Office Action.

### **The Byers Declaration**

The Declaration Under 37 CFR 1.131 of Robert Andrew Byers, Jr. (the Byers Declaration), was not considered effective in antedating the Wilner reference due to the assertion that the Declaration fails to state that the activity was carried out in this country or a NAFTA country. The Applicant respectfully disagrees that the Declaration is ineffective and notes that 37 CFR 1.131 does not require that the Declaration include statement that the activities were carried out in this country or a NAFTA country. Rather, it states "(t)he oath or declaration must include facts showing completion of the invention in this country or a NAFTA or WTO member country". The Applicant asserts that the Exhibits to the Byers Declaration clearly show that the invention was completed in the U.S.

The Applicant understands that it needs only to obtain a new Declaration with this explicit statement in order to overcome the Willner reference and the Applicant continues to assert that the Willner reference is not prior art to the present application. Notwithstanding these assertions, as the new rejections use the Gavarini reference for the same purpose as the Willner reference; i.e. to show a system in which only the quantity and time period must be entered in order for an order to be placed, the Applicant has elected to forego the submission

of a new Declaration and asks that the Willner reference be treated as prior art solely for purposes of examination.

**Rejections Under 35 USC §103**

Claims 1-2, 5, 8-9, 15-16, 18-19, 21-30, 23-33 and 35-42 were again rejected as obvious in light of the Barnes reference in further view of the Willner reference. In addition, all claims were likewise rejected based upon the new Gavarini reference. In all rejections, it was asserted that the Barnes reference teaches a “user specific purchase history form comprising all products that were purchased during a specified time period” and that the other references, i.e. Willner or Gavarini, teach that the specified time period and the quantity are the only fields where data entry is required.

In its “Amendment” filed on October 8, 2005, the Applicants responded to these same rejections by asserting that the Applicants’ claims are unobvious even if the Willner reference were prior art and submitted the “Declaration Under 37 CFR§1.132 of Kenneth R. Taylor” (the “Taylor Declaration”) in support of this assertion. In response, the Examiner dismissed the Taylor Declaration as stating unsupported legal conclusions and renewed the rejections in the Office Action of December 29, 2005. In response to this Office Action, the Applicant’s filed another Amendment on May 30, 2006, in which the Applicants incorporated their prior arguments by reference and explained why the Taylor Declaration did not merely state legal conclusion and should have been considered. In response, the Examiner issued the Office Action of August 24, 2006, in which it renewed its rejections and added the Gavarini reference as a further basis for rejection.

The Applicants again incorporate their prior arguments, and the Taylor Declaration, by reference into this Response and assert that these arguments and the Declaration are equally applicable to the rejections based upon the Gavarini reference.

The Applicants strongly object to Examiner's failure to find that the Taylor Declaration is sufficient to overcome the rejections and asserts that the Taylor Declaration was timely filed, was made by qualified Declarant, is fully responsive to the rejections and presents sufficient facts to overcome the rejection, as required under MPEP §716.

First, the Examiner has not objected to Mr. Taylor's declaration that he is "one of at least ordinary skill in the arts of software design and programming, including the design and programming of methods and systems for selling products over computer networks" nor had the Examiner stated that the arts set forth in the Declaration are the relevant arts for purposes of the claimed subject matter. Accordingly, Mr. Taylor must be considered to be one of ordinary skill in the relevant arts.

Second, the Examiner has not objected to the Taylor Declaration on the grounds that it is not fully responsive to the rejections. As noted in the Applicants' prior Amendment, MPEP § 2142 states:

"(t)o establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art references must teach or suggest all of the claim limitations."

Paragraphs 5 – 8 of the Taylor Declaration set forth declarations that are fully responsive to the rejections insofar as each rebuts the Examiner's assertion that a prima facie case of obviousness has been established. In particular, paragraph 5 includes that declaration that

“the Barnes reference does not disclose or suggest a user specific purchase history form comprising all products that were purchased during a specified time period”, which rebuts the third criteria. Paragraphs 6 – 8 includes declarations that Mr. Taylor would not be motivated to modify Barnes (§6) or to combine the Barnes reference with the Willner reference (§§7 & 8), and that Willner teaches away from such a combination (§8). Finally, paragraph 9 of the Taylor Declaration provides objective evidence of nonobviousness. As the only rejections are based upon the obviousness of the Applicants’ claims, and the Taylor Declaration provides evidence that fully rebuts these rejections, the Taylor Declaration meets this requirement.

As best understood, the sole objection to the Taylor Declaration appears to be that it does not present sufficient facts to overcome the rejection. In the Office Action, it was asserted that Mr. Taylor’s declarations were opinions and “the Declaration was found not to be persuasive because the opinions are legal conclusions and lack factual support.” The Applicants admit that paragraph 9 of the Taylor Declaration does set forth Mr. Taylor’s opinions regarding the objective factors, or secondary obviousness considerations. However, the Applicants strongly disagree that paragraphs 5 – 8 set forth opinions, or that these paragraphs lack sufficient factual support to rebut the Examiner’s assertion that she has established a prima facie case of obviousness.

Looking first to Paragraph 5 of the Taylor Declaration, Mr. Taylor addresses the Examiner’s assertion that Barnes discloses or suggests a user specific purchase history form comprising all products that were purchased during a specified time period. In addressing this assertion, Mr. Taylor states:

“I declare that the Barnes reference does not disclose or suggest a user specific purchase history form comprising all products that were purchased

during a specified time period, as claimed in each of the applicants' claims. In particular, I declare that a repeat of an old requisition request, which was asserted by the examiner to read on this limitation, does not provide the buyer with a list of all products purchased during a specified time period, nor does it provide the same advantages as the claimed user specific purchase history form. **This declaration is based upon the fact that each old requisition request would include only those items purchased on that particular requisition request, which would require the buyer to search for and add products that were not included on the old requisition request, and would not allow the buyer to differentiate between similar products when placing their order. Conversely, the user specific purchase history form described and claimed by the applicant includes all products purchased within the time period, which allows the buyer to place an order for any combination of previously ordered products and to easily recognize that similar products have been ordered in the past and to differentiate between the similar products when placing their order.** *Taylor Dec.*, ¶5 (Emphasis added)

The declaration in paragraph 5 directly addresses what the Barnes reference teaches and rebuts the Examiner's assertion of what Barnes teaches. It is long established that what a reference teaches is a question of fact and not law. See Winner International Royalty Corp. v. Wang, 202 F.3d 1340, 53 USPQ2d 1580 (Fed. Cir. 2000). Therefore, the declarations made in paragraph 5 cannot be legal conclusions, as asserted by the Examiner. Further, even if the paragraph were found to set forth an opinion, which the Applicants deny, the bolded portion of paragraph 5 clearly provides the factual support for any such opinion. Therefore, the Applicant asserts that paragraph 5 of the Taylor Declaration presents sufficient facts to show that the Barnes reference does not teach the claimed limitation relied upon by the Examiner in her rejection and, accordingly, presents facts that are sufficient overcome the rejection.

The declarations in paragraphs 6 – 8 directly address the question of whether there is a motivation to modify Barnes, or combine it with other references, to obtain the claimed invention. It is also long established that the question of whether there would be motivation to combine reference is a question of fact and not law. See McGinley v. Franklin Sports,

Inc., 262 F.3d 1339, 60 USPQ2d 1001 (Fed. Cir. 2001). Therefore, Mr. Taylor's declarations that he "would not be motivated to modify the Barnes reference to include the user specific purchase history form claimed by the applicant", and that he "would not be motivated to combine the Barnes and Willner references cited by the Examiner to obtain a system including a user specific order entry form where a quantity entry field is the only fields in which entry of data by the user is required to purchase a product" cannot set forth legal conclusions, as asserted by the Examiner.

Even if the paragraph 6 – 8 were found to set forth opinions, which the Applicants deny, the bolded portions of paragraphs 6 and 7 set forth below clearly provides the factual support for any such opinion:

**"I declare that I would not be motivated to modify the Barnes reference to include the user specific purchase history form claimed by the applicant. This declaration is based partly upon the fact that the system disclosed in the Barnes reference allows a buyer to view only certain portions of the suppliers catalog based upon user settings managed by the by organization. Therefore, because buyers may not order all products previously purchased by the buyer's organization, there would be no need to modify the Barnes reference to include the user specific purchase history form claimed by the applicant. This declaration is also based upon the fact that the system disclosed in the Barnes reference does not allow users to place orders directly from prior requisitions."** Taylor Dec., ¶6 (Emphasis added).

**"I declare that I would not be motivated to combine the Barnes and Willner references cited by the Examiner to obtain a system including a user specific order entry form where a quantity entry field is the only fields in which entry of data by the user is required to purchase a product. I further declare that such a combination would not result in a method system or computer product that provides the advantages of the applicant's invention. These declarations are based upon the fact that Barnes fails to address the principal problem that is solved by the Applicants' claimed invention; i.e. the risk of error by insertion of incorrect part numbers and pricing on order forms. Barnes allows products to be ordered in two distinct ways; by allowing the user to browse through portions of the suppliers catalog to choose the desired products and add them to a requisition, in a manner similar to they would were they to browse through a catalog, and by allowing the**

**user to effectively repeat transactions that have been previously set-up, as in cases where user generated templates are used or where prior requisitions of particular products are copied. I declare that each of these ways of placing an order is time consuming and has a significant risk of error. Where a new requisition is made, or a template set up, the user must sort through entire portions of the supplier's catalog in order to find the product or products that they need. In cases where similar products are found in the catalog and the user is unsure of which to choose, the user must go back to run reports on previously ordered products, find the correct product, go back to the order form, and enter the correct product in the form. I declare that this problem is not eliminated in cases where templates are used or prior requisitions are repeated, as the user must find the correct prior requisition or template on the system, which can be time consuming and prone to error. Further, the user cannot add products directly to this requisition or template. Instead, the user is forced to create a new requisition or template in order to accomplish this task. I declare that each of these means for ordering products using the Barnes system is time consuming and prone to error. Accordingly, there is nothing in the Barnes disclosure that would suggest that it be modified to include the user specific purchase history form claimed by the applicants. Taylor Dec., ¶7 (Emphasis added).**

Therefore, the Applicant asserts that paragraph 6 and 7 of the Taylor Declaration present sufficient facts to show that there would be no motivation to modify Barnes, or combine it with other references, to obtain the claimed invention, as asserted by the Examiner in her rejection. Further, paragraph 7 presents sufficient facts to show that such a combination would not have a reasonable expectation of success. Accordingly, the Applicants assert that paragraphs 6 and 7 of the Taylor Declaration present facts that are sufficient overcome the rejection.

Regarding paragraph 8 of the Taylor Declaration, the Applicants note that the question of whether a reference teaches away from the claimed invention is also a question of fact and not law. See In re Harris, 409 F3d. 1339 (Fed. Cir. 2005). Accordingly, paragraph 8 of the Taylor Declaration cannot set forth a legal conclusion, as asserted by the Examiner. Paragraph 8 states:

I declare that the Willner reference teaches away from the use of the claimed user specific order entry form **because it discloses a purchasing system for internal use by a buyer organization in order to simply the internal requisition process and not a system for use by a buyer and a seller. The Willner reference requires the user to select products from a database of vendor catalogs managed by the buyer's organization and does not provide any means for the user to view prior purchases.** I declare that, were such a feature included or suggested, that there would be no need for the "compatibility check" performed by the Willner system. Taylor Dec., ¶7 (Emphasis added).

Even if the paragraph were found to set forth an opinion, which the Applicants deny, the bolded portion of paragraph 8 clearly provides the factual support for any such opinion. Therefore, the Applicant asserts that paragraph 8 of the Taylor Declaration presents sufficient facts to show that the Willner reference teaches away from its combination with Barnes and, accordingly, presents facts that are sufficient overcome the rejection.

Because the Applicants assert that the Taylor Declaration directly rebuts the Examiner's alleged prima facie case of obviousness, the Applicants have not addressed the objective factors of nonobviousness. However, the Applicants likewise assert that paragraph 9 of the Taylor Declaration provides sufficient facts to support Mr. Taylor's opinions regarding the objective factors of nonobviousness and that these facts are sufficient to overcome the rejections.

Finally, the Applicants assert that neither the Gavarini reference, nor any of the other references cited by the Examiner, discloses or suggests a user specific purchase history form comprising all products that were purchased during a specified time period, or provides any suggestion to modify the Barnes reference to include such a feature. Accordingly, the Applicants assert that their prior arguments, and the Taylor Declaration, are fully responsive to



the rejections based upon the Gavarini reference and are sufficient to overcome these rejections as well.


The Applicants sincerely hopes that they will not be forced to incur the time and expense associated with the appeal process due to the Examiner's failure to properly consider the Taylor Declaration and respectfully requests that the Examiner fully reconsider the rejections in view of the Taylor Declaration and the remarks, both herein and previously presented, and allow the claims.

For the reasons set forth above, and those set forth in the "Amendments" filed on October 8, 2005, and May 30, 2006, the Applicants assert that claims 1-2, 5, 8-9, 15-16, 18-19, 21-30, 23-33 and 35-42 are unobvious. Accordingly, the Applicants respectfully request that the Examiner reconsider these rejections and allow all pending claims.

#### **Conclusion**

It is felt that a full and complete response has been made to the Official Action and, as such, places the application in condition for allowance. Such allowance is hereby respectfully requested. If the Examiner feels, for any reason, that a personal interview will expedite the prosecution of this application, the Examiner is invited to phone the Applicants' attorney at the number set forth below.

Respectfully submitted,



Date March 21, 2008

Michael J. Persson  
Attorney for Applicant  
Registration No. 41,248  
Lawson & Persson, P.C.  
P.O. Box 712  
Laconia, NH 03247  
Phone: 603-528-0023  
Fax: 603-528-3332